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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,036	02/18/2005	Norio Komaki	L8612.05107	3501
24257 7590 10/25/2007 STEVENS DAVIS MILLER & MOSHER, LLP 1615 L STREET, NW SUITE 850 WASHINGTON, DC 20036			EXAMINER KHAN, SHAFIQL H	
			ART UNIT 4183	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/525,036

**Applicant(s)**

KOMAKI, NORIO

**Examiner**

Shafiqul Khan

**Art Unit**

4183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This office action is response to the application (10/525036) files on 21 Aug 2003.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding Claim 6, claim 6 recites the limitation "said control unit". There is insufficient antecedent basis for this limitation in the claim. Applicant doesn't imply anywhere else about this "said control unit" before this claim.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application

filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1,3,5,6,7 are rejected under U.S.C 102(e) as being anticipated by Son et al. (JP 2002-160537).

Regarding Claim 1, Son discloses an IP network, which is based on TCP/IP and makes possible to exchange packet from one terminal (IP phone) to a different terminal, which is a medium of performing communication. (Page 18, lines 24-26); the IP address, Mac address and ID (domain name server) are stored in a multifunctional telephone (30a) (remote terminal or local terminal) (Page 18, lines 39-40; page 19, line 1; lines 17-40); a voice-processing unit that encodes and decodes voice signal over IP network. VOIP (voice over IP) is an application disclosed by Son, which converts analog signal to digital signal and digital to analog over IP network. (Page 22, lines 9-14); a dialing pad is an input for the caller to call (Page 21, lines 36- 38 and Figure 10 [30a]). As soon as the user inputs on the dialing pad, IP address and Mac address are sent to the control server (13), which is a part of the management server (14) and ISP provides an IP address to the multifunctional telephone (30a) (Page 23, lines 38-40; page 24, lines 3-5 and lines 11-13).

Regarding Claim 3, Son discloses that his invention is a multifunctional telephone, which is connected to IP network as an IP phone (30a). (Figure10).

Regarding Claim 5, Son discloses a video telephony application (48) that serves as a videophone-processing unit that encodes image signal into a receiver unit and

Art Unit: 4183

decodes from the packet transmitter receiver unit and displays it on the display screen (Page 23, lines 10-20).

Regarding Claim 6, Son discloses a multifunctional telephone (30a) (IP phone) sends Mac address and IP address to database searching unit (13c) (management server (14) is interrelated with database unit) for authentication (registration) of local and remote terminals (Fig 10; Page 19, lines 29-32).

Regarding Claim 7, Son discloses a multifunctional phone (IP Phone) that is capable of having a control unit (connection processing unit, VOIP application, signal processing unit; Fig 11) that sends request for IP address and receives it from DHCP (Dynamic Host configuration Protocol (DHCP) that automatically configures hosts that connect to TCP/IP network and assigns new IP address upon request; this concept is commonly known in network world) and capable of informing call manager about the update (address server) (Page 18, lines 36-40; page 19, lines 1-5).

6. Claim 8 and 9 are rejected under U.S.C 102 (e) as being anticipated by Huat et al. (US 7072959 B2).

Regarding claim 8, Huat discloses a server that has a communication portion, which has an interface to communicate with a network. (Column 9, lines 25-36); a memory as a storing device, relating to the plurality of network, is capable to have conversion table by using APR or RAPR (address resolution protocol or reverse address resolution protocol; not cited in the reference but it's commonly known as a conversion table before the invention of the applicant) which can store Mac address and IP address (network addresses) (Column 6, lines 3-4 and lines 32-35; column 5, line

Art Unit: 4183

28; column 9, lines 28-30, lines 31-40); a processor that can operate as a control unit is capable of determining network addresses which is adding Mac address and IP address into conversion table of the memory and giving feed back to the terminal or server of an IP address (Column 9, lines 30-40; column 4, lines 14-25).

Regarding Claim 9, Huart discloses that DHCP server can assign network addresses dynamically and automatically. Thus DHCP is capable of updating the IP address and as a result, IP address in the conversion table is updated (Column 3, lines 56-60; column 4, lines 16-18; column 11, lines 59-67).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son et al. (JP 2002-160537) in view of Huart et al. (US 7072959B2).

Art Unit: 4183

Regarding claim 2, Son teaches an IP phone but doesn't distinctly specify a plurality of network terminals.

Huart, in the same field of invention, discloses plurality of network terminal devices connected to subnet and creates a set or region. (Sheet 1, figure 1). The purpose of this is to communicate within multiple devices. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have plurality of network terminal device connected to a subnet taught by Huart, in Son, in order to make a plurality of network terminals (Sheet 1, figure 1).

Regarding Claim 4, Son teaches an IP phone with buttons on the dialing pad but doesn't teach how this button is interconnected into remote terminals (IP phone).

(Figure 10)

Huart, in the same field of invention, discloses plurality of network terminal devices with buttons in each terminal connected to a subnet. The purpose of this is to use as an input of the device. Therefore, it would have been obvious to one skilled in the art at the time of invention was made to include a plurality of network taught by Huart, in Son, in order to show the input device with buttons (Sheet 1, figure 1).

8. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son et al. (JP 2002-160537) in view of Huart et al. (US 7072959B2).

Regarding Claim 11, Son teaches an IP network with an IP phone which is based on TCP/IP and makes possible to exchange packet from one terminal (IP phone) to a

Art Unit: 4183

different terminal, which is a medium of performing communication. (Page 18, lines 18-26); the IP address, Mac address and ID (domain name server) are stored in a multifunctional telephone (30a) (remote terminal or local terminal) (Page 19, lines 11-35); Son fails to teach plurality of remote terminals interconnected together.

Huart, in the same field of invention, discloses a server that has a communication portion, which has an interface to communicate with a network (Column 9, lines 25-36); a memory as a storing device, relating to the plurality of network, is capable to have conversion table by using APR or RAPR (addressed resolution protocol or reverse addressed resolution protocol; not cited in the reference but it's commonly known as a conversion table before the invention of the applicant) which can store Mac address and IP address (network addresses). (Column 6, lines 3-4 and lines 32-35; column 5, line 28; column 9, lines 28-30, lines 31-40); a processor that can operate as a control unit is capable of determining network addresses which is adding Mac address and IP address into conversion table of the memory and giving feed back to the terminal or server of an IP address. (Column 9, lines 30-40; column 4, lines 14-25). Both reference teach to communicate between local terminals and remote terminals (IP phone). The purpose of this is to describe a server. Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to combine Server taught by Huart, in Son, to build a communication system comprising with a network terminal device and a server; thus make voice communication as it's taught on both reference.

Regarding Claim 12, Son teaches a server similar to DNS server. Therefore,



Art Unit: 4183

It would have been obvious to one skilled in the art at the time of the invention was made to interpret server as a domain name server because it has the similar functionality as a DNS, thereby, understand applicant's invention is a same invention previously applied.

Regarding Claim 13, Son teaches a server similar to DNS server. ENUM server is simply a convergence of PSTN (public switched area network) to IP network that is widely known. Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to use an ENUM server since this would depend on design choice.

Regarding Claim 14, Son teaches IP connection and how voice communication is performed via IP network and use of Mac and IP addresses; however, doesn't distinctly teach DHCP server and its function. Huart, in the same field of invention, discloses DHCP server can assign network addresses dynamically and automatically. Thus DHCP is capable of updating the IP address and as a result, IP address in the conversion table is updated (Column 3, lines 56-60; column 4, lines 16-18; column 11, lines 59-67). Therefore, it would have been obvious to one skilled in the art at the time of the invention was made to have Son, taken from Huart, do the exact same function as claimed in this claim.

9. Claims 15-18 are rejected under 35 U.S.C 103(a) as being unpatentable over Son et al. (JP 2002-160537) in view of Huart et al. (US 707295B2).

Regarding claims 15-18, Son teaches plurality of network, IP phone, plural send buttons and display unit including image-processing part. But fails to teach the interconnection between these (15-18) claims with the 2-5 claims. Huart, in the same field of invention, discloses a processor as a control unit (column 5, line 7) coupled to network (102), network endpoint (IP phone) sends a request for a network address to server. The purpose of Huart's invention discloses requesting for authentication of network addresses from server and shows the connection between Claims 15-18 to claims 2-5. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have include the additional information (described above) taught by Huart, in Son, in order to further show the interconnection between claims 15-18 to claims 2-5 and control unit.

10. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Son et al. (JP 2002-160537) in view of Huart et al. (US 7072959B2).

Regarding Claim 10, Son teaches the system regarding IP phone, storing Mac address of a 'local terminal and remote terminal' and IP address of the server (Page 19, lines 17-35, Page 20, lines 23-31; Page 9, lines 9-12) and IP phone itself but doesn't teach method of IP phone. Huart, in the same field of invention, discloses a method of the network by determining (inquiry), assigning (connecting), receiving (storing) which is the same field of endeavor as the applicant tries to claim in his method. The purpose of Huart's invention is to describe the method of a network communication. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to

Art Unit: 4183

have include the method of network communication taught by Huart, in Son, in order to create steps for the method of network communication (Col 8, lines 52-67; Col 9, lines 1-20).

### ***Conclusion***

#### **Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shafiqul Khan whose telephone number is 5712701952. The examiner can normally be reached on Monday to Thursday 7:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on 5712721184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 4183

*Shafiqul Khan*

Shafiqul Khan

Patent Examiner

10/11/07

*Lentran*  
**LENTAN**  
**PRIMARY EXAMINER**  
*Supern*  
*6/17/07*

